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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,010	07/09/2003	Ian Shaw Burnett	90204	1012

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EXAMINER
MURDOUGH, JOSHUA A

ART UNIT	PAPER NUMBER
3609	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

		Application No.	Applicant(s)
Office Action Summary		10/616,010	BURNETT ET AL.
		Examiner	**Art Unit**	
		Joshua Murdough	3609	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 December 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-27</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-27</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>09 July 2003</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☒ None of:

        1.☒ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>1/18/2005, 9/8/2003</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application

filed in Australia on 7/11/2002. It is noted, however, that applicant has not filed a certified copy

of the 2002950202 application as required by 35 U.S.C. 119(b).

Drawings

The drawings are objected to because, in Figure 1, terminal has been marked through

instead of being removed. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are

required in reply to the Office action to avoid abandonment of the application. Any amended

replacement drawing sheet should include all of the figures appearing on the immediate prior

version of the sheet, even if only one figure is being amended. The figure or figure number of an

amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the

appropriate figure must be removed from the replacement sheet, and where necessary, the

remaining figures must be renumbered and appropriate changes made to the brief description of

the several views of the drawings for consistency. Additional replacement sheets may be

necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after

the filing date of an application must be labeled in the top margin as either "Replacement Sheet"

or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office

action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 5-7, 11, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 3, 5, 11, and 13; the use of "other predetermined information" is indefinite without some explanation as to what the information is or where it comes from. The Examiner has, under the broadest reasonable interpretation, taken this to require the configuring of the device based on any information, from any source, when evaluating it on the merits.

As to claim 6, it depends from claim 5 and does not elaborate on the information's source or content. Therefore, it is rejected under the same basis.

As to claim 7, the use of "and/or" is indefinite as to which limitations or combinations are actually being claimed. In order to expedite prosecution the Examiner has interpreted this to just say "or."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 8, 9, 14, 15, 17, 24, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Iannella (ODRL).

As to claim 1, Iannella shows:

A method of enabling a Digital Item to be consumed or otherwise manipulated according to a set of operations defined by the Digital Item author or other entitled party, (Section 2.2)

the method including the step of incorporating a Digital Item manipulation method or methods defining said set of operations into the Digital Item. (Section 2.12)

As to claim 8, Iannella further shows:

the Digital Item manipulation method includes an Intellectual Property Management and Protection (IPMP) mechanism. (Section 2.2)

As to claim 9, Iannella further shows:

the step of protecting said device using said IPMP mechanism. (Section 2.2)

As to claim 14, Iannella further shows:

said set of operations is described in a script.

The commonly accepted definition of a script is: "A set of commands written in an interpreted language to automate certain application tasks." When the code of ODRL is interpreted, there are automatic control tasks that are executed, such as allowing or denying access. Therefore, the use of ODRL to perform these tasks also shows that the operations are in a script.

As to claim 15, Iannella further shows:

said script is included in the Digital Item as a resource within the Digital Item

accessed by a reference URI from the Digital Item declaration (Section 2.7 –

External Reference)

As to claim 24, Iannella further shows:

a step of determining whether the device can perform the Digital Item manipulation

method. (Section 2.3 – Device Constraint)

As to claim 25, Iannella further shows:

the step of identifying elements of the Digital Item which can be processed by the

Digital Item manipulation method. (Section 2.3 – Target Constraints)

As to claim 17, Iannella further shows:

said script is referenced by an identifier such that a device, or a family of devices

might have the operations of said script in-built at manufacture or by later

modification

As previously shown, Iannella allows for reference to an external script, (Section 2.7 –

External Reference) and also allows for execution based on hardware (Section 2.3 – Device

Constraint). In combination, these elements allow for a script referenced by an identifier to a

location on a device to be run if the device meets certain criterion, such as being in a certain

family of devices.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Song

(20020095429) in view of Official Notice.

Song shows:

A method of enabling a Digital Item to be consumed or otherwise manipulated

according to a set of operations defined by the Digital Item author or other

entitled party, (Paragraph 37)

the method includes the following steps:

incorporating a Digital Item manipulation method or methods defining said set of

operations into a Digital Item; (Figure 1)

providing said Digital Item, or a Digital Item declaration to a device; (Paragraph 2,

being transferred shows that it is being provided to another device)

Song does not show:

enabling said device to:

a. determine an appropriate Digital Item manipulation method or methods for the

application;

b. retrieve said appropriate Digital Item manipulation method or methods;

c. interpret said set of operations from said appropriate digital item manipulation

method or methods; and

d. perform interpreted set of operations from said digital item manipulation method or

methods on said digital item

The Examiner takes official notice that it is notoriously old and well known in the art to use a direct execution interpreter, which performs the steps a-d above, in conjunction with a script. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention of Song to have used a direct execution interpreter to allow for the execution of the code on a broad range of devices.

As to claims 3 and 5, Song further shows:

receive and be configured on the basis of other predetermined information (Figure 1, 104f)

As to claims 4 and 5, Song further shows:

configure said appropriate Digital Item manipulation method or methods for said Digital Item (Paragraph 77)

As to claim 6, Song further shows:

the Digital Item manipulation method is provided within the Digital Item or the Digital Item declaration. (Figure 1)

As to claim 7, Song further shows:

the other predetermined information includes information regarding user preferences, device capabilities and/or consumption environment. (Paragraph 12)

Claims 10-13, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Song (20020095429) in view of Official Notice.

Song shows:

Apparatus for enabling a Digital Item to be consumed or otherwise manipulated

according to a set of operations defined by the Digital Item author or other

entitled party, (Paragraph 37)

the apparatus including:

means for incorporating a Digital Item manipulation method or methods defining said

set of operations into a Digital Item; (Figure 1)

means for providing said Digital Item, or a Digital Item declaration to a device;

(Paragraph 2, being transferred shows that it is being provided to another device)

Song does not show:

said device including:

means for determining an appropriate Digital Item manipulation method or methods

for the application;

means for retrieving said appropriate Digital Item manipulation method or methods;

means for interpreting said set of operations from said appropriate Digital Item

manipulation method or methods; and

means for performing said interpreted set of operations from said Digital Item

manipulation method or methods on said Digital Item.

The Examiner takes official notice that it is notoriously old and well known in the art to

use a direct execution interpreter, which provides the means for performing the steps above, in

conjunction with a script. It would have been obvious to one of ordinary skill in the art at the

time of the invention to have modified the invention of Song to have used a direct execution

interpreter to allow for the execution of the code on a broad range of devices.

As to claims 11 and 13, Song further shows:

means for receiving and being configured on the basis of other predetermined

information (Figure 1, 104f)

As to claims 12 and 13, Song further shows:

means for configuring said appropriate Digital Item manipulation method or methods

for said Digital Item (Paragraph 77)

As to claim 26, Song further shows:

means for determining whether the device can perform the Digital Item manipulation

method. (Figure 1, 102d)

As to claim 27, Song further shows:

means for identifying elements of the Digital Item which can be processed by the

Digital Item manipulation method. (Figure 1, 102e)

Claims 10, 18-21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Iannella in view of Official Notice.

Iannella shows:

Apparatus for enabling a Digital Item to be consumed or otherwise manipulated

according to a set of operations defined by the Digital Item author or other

entitled party, (Section 2.2)

the apparatus including:

means for incorporating a Digital Item manipulation method or methods defining said

set of operations into a Digital Item; (Section 2.12.1)

means for providing said Digital Item, or a Digital Item declaration to a device;

(Paragraph 11, being transferred shows that it is being provided to another device)

Iannella does not show:

said device including:

means for determining an appropriate Digital Item manipulation method or methods

for the application;

means for retrieving said appropriate Digital Item manipulation method or methods;

means for interpreting said set of operations from said appropriate Digital Item

manipulation method or methods; and

means for performing said interpreted set of operations from said Digital Item

manipulation method or methods on said Digital Item.

The Examiner takes official notice that it is notoriously old and well known in the art to

use a direct execution interpreter, which provides the means for performing the steps above, in

conjunction with a script. It would have been obvious to one of ordinary skill in the art at the

time of the invention to have modified the invention of Iannella to have used a direct execution

interpreter to allow for the execution of the code on a broad range of devices.

As to claim 18, Iannella further shows:

the Digital Item manipulation method includes an Intellectual Property Management

and Protection (IPMP) mechanism. (Section 2.2)

As to claim 19, Iannella further shows:

means for protecting said device using said IPMP mechanism. (Section 2.2)

As to claim 20, Iannella further shows:

said set of operations are described in a script.

The commonly accepted definition of a script is: "A set of commands written in an interpreted

language to automate certain application tasks." When the code of ODRL is interpreted, there

are automatic control tasks that are executed, such as allowing or denying access. Therefore, the

use of ODRL to perform these tasks also shows that the operations are in a script.

As to claim 21, Iannella further shows:

said script is included in the Digital Item as a resource within the Digital Item

accessed by a reference URI from the Digital Item declaration (Section 2.7 –

External Reference)

As to claim 23, Iannella further shows:

said script is referenced by an identifier such that a device, or a family of devices

might have the operations of said script in-built at manufacture or by later

modification

As previously shown, Iannella allows for reference to an external script, (Section 2.7 –

External Reference) and also allows for execution based on hardware (Section 2.3 – Device

Constraint). In combination, these elements allow for a script referenced by an identifier to a

location on a device to be run if the device meets certain criterion, such as being in a certain

family of devices.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iannella in view

of Song.

Regarding claim 16, it can be seen that, as applied to claim 14, Iannella shows all of the

elements except:

said script is provided within the Digital Item declaration itself as a descriptor

Song shows the use of the descriptor for "the purpose of selective item configuration." (Paragraph 77) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention of Iannella, so that the script was in the descriptor because, this would have allowed the digital item to be adapted to "various types of networks and terminals, or user requests." (Paragraph 77)

Claims 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iannella in view of Official Notice as applied to claim 20 above, and further in view of Song.

Iannella in view of Official Notice shows all of the elements except:

said script is provided within the Digital Item declaration itself as a descriptor

Song shows the use of the descriptor for "the purpose of selective item configuration." (Paragraph 77) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention of Iannella, so that the script was in the descriptor because, this would have allowed the digital item to be adapted to "various types of networks and terminals, or user requests." (Paragraph 77)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Murdough whose telephone number is (571) 270-3270. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeff Smith can be reached on (571) 272-6763. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

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